REMARKS

This responds to the Office Action mailed on May 4, 2007.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-49 remain pending in this application.

Regarding the response to arguments in the Office action

In the "Response to Arguments" section, the Office action states that Applicant's arguments filed February 2007 have been fully considered and are considered moot in view of newly added grounds of rejection.

Applicant's arguments filed February 2007 included a discussion substantiating that the combination of Lencki and Wolff is improper. In particular, it was pointed out that while Wolff discloses life insurance *providers submitting bids* based on Insurability Documentation File for a particular prospective insured party (Wolff, Abstract), such bidding mechanism used by insurers is useless in the context of Lencki, where a prospective recipient of insurance benefits (the employee) is permitted to select from upgraded and supplemental benefits *once the employer has determined the minimum benefit package for the company* (Lencki [0082]). Furthermore, it was explained that Lencki and Wolff disclosures teach away from the method of claim 1. Specifically, because in Lencki an on-line activity of an employee is related merely to supplemental benefits from discreet line items in conjunction with the minimum benefit package *predetermined by the employer* (Lencki [0082]), Lencki teaches away from "presenting a user interface to an applicant over the network, the user interface including information pertaining to a medical plan selected by the applicant and facilitating input of application data by the applicant" and "creating a finalized health insurance application," as recited in claim 1. With respect to Wolff, it was explained that an Insurability Documentation File that contains the information needed by underwriters or insurers to evaluate the insurability rating of the prospective insured party (Wolff, Abstract) is distinct from a health insurance application, and treating it as such would defeat the purpose of soliciting bids from insurers, which is the stated purpose of Wolff (Wolff, [0013]). Thus, Wolff teaches away from "obtaining a confirmation from the applicant that the applicant intends to be legally bound by the electronic signature" and

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"transforming the application data into a secure digital file thereby creating a finalized health insurance application," as recited in claim 1.

It is submitted that the issue of whether the combination of Lencki and Wolff is proper remains relevant, and is not moot, where such combination, in view of a newly added reference (Smithies), is relied upon in the §103 rejections of the claims, as in the current Office action, mailed on May 4, 2007.

§103 Rejections of the Claims

Claims 1-7, 9-32, and 34-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lencki et al. (U.S.2002/0049617) in view of Wolff et al. (U.S. 2002/0029158) and further in view of Smithies et al. (U.S. 6,091,835).

The Combination of Lencki, Wolff, and Smithies is Not Proper

As discussed above, as well as in the response to Office action filed February 2007, the combination of Lencki and Wolff is not proper because the bidding in Wolff (Wolff, Abstract) is useless in the context of employee selecting supplemental benefits in addition to the core package determined by the employer (Lencki [0082]), and therefore it would not be obvious to one of ordinary skill in the art to have combined the teachings of Lencki with those of Wolff. It is submitted that introducing a further reference (Smithies) into the Lencki and Wolff combination does not remedy this deficiency. Thus, because the combination of Lencki and Wolff is not proper, the combination of Lencki, Wolff, and Smithies is also not proper. Accordingly, claims 1-7, 9-32, and 34-49 are patentable in view of Lencki, Wolff, and Smithies combination and should be allowed.

Lencki and Wolff Teach Away From the Subject Matter of the Rejected Claims

Furthermore, also discussed above, as well as in the response to Office action filed February 2007, Lencki and Wolff disclosures each teach away from the method of claim 1, from the system of claim 27, from the apparatus of claim 28, and from the computer-readable medium of claim 48. Because Lencki and Wolff disclosures each teach away from the subject matter of

claims 1-7, 9-32, and 34-49, claims 1-7, 9-32, and 34-49 are patentable in view of a combination that includes either Lencki or Wolff. Accordingly, claims 1-7, 9-32, and 34-49 are patentable in view of Lencki, Wolff, and Smithies combination and should be allowed.

Lencki, Wolff, and Smithies Combination Does Not Disclose Each Element of the Rejected Claims

The Office action correctly stated that Lencki fails to disclose assembly of user information into a single secure document for transmission to insurance carriers. More particularly, referring to the wording in the claims, Lencki fails to disclose or suggest creating a finalized health insurance application by transforming the client data into a secure digital file. The Office action cites Wolff to show this feature. The insurability documentation file disclosed in Wolff is electronically transmitted over a secure network to participating insurance companies in order to evaluate the insurability of the prospective insured party (Wolff, [0018]). It is submitted that an electronic document that is not a secure digital file (e.g., a document that may be edited) may be transmitted over a secure network. Thus, while Wolff discloses transmitting the insurability documentation file over a secure network, Wolff fails to disclose "transforming the client data into a secure digital file," as recited in claim 1.

In order to show creating a finalized health insurance application by transforming the client data into a secure digital file, the Office action cites the passage in Wolff as shown below.

> Upon the acceptance of a bid by the customer, authorized agent, or authorized wholesaler, the customer or his representative will prepare the official approved *insurance application form* and submit it to the selected insurance carrier. In the preferred embodiment of the invention, this application may be downloaded from a web site associated with the centralized insurance file assembly system.
>
> (Wolff, [0020], emphasis added.)

It is clear from the excerpt above that the insurance application form is not the same as the insurability documentation file (cited by the Office action to show a secure digital file). Furthermore, there is no indication in Wolff that the insurance application *form* does not need to be filled out or at least signed by the customer, and thus is not a secure digital file. Also, the

insurance application *form* is distinct from a finalized health insurance application, because an insurance application *form* may still need to be filled out and signed.

Thus, Wolff, whether considered separately or in combination with Lencki and Smithies, fails to disclose "transforming the client data into a secure digital file" in general and "transforming the client data into a secure digital file **thereby creating a finalized health insurance application**" in particular.

Smithies is directed at a method and system for transcribing electronic affirmations (Smithies, Title) and also fails to disclose this element of claim 1, whether considered separately or in combination with Lencki and Wolff.

Thus, because not every element of claim 1 is disclosed by the combination of Lencki, Wolff, and Smithies, claim 1 and its dependent claims are patentable in view of the Lencki, Wolff, and Smithies combination and should be allowed.

Claim 27 recites "a transaction facility coupled to plurality of client devices to transform the client data into a secure digital file thereby creating a finalized health insurance application." Therefore, claim 27 is patentable in view of the Lencki, Wolff, and Smithies combination for at least the reasons articulated with respect to claim 1.

Claim 28 recites "an application data processor to transform the application data into a secure digital file thereby creating a finalized health insurance application." Therefore, claim 28 and its dependent claims are patentable in view of the Lencki, Wolff, and Smithies combination for at least the reasons articulated with respect to claim 1.

Claim 48 recites "transforming the application data into a secure digital file thereby creating a finalized health insurance application." Therefore, claim 48 is patentable in view of the Lencki, Wolff, and Smithies combination for at least the reasons articulated with respect to claim 1.

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Claims 8 and 33 were rejected under 35 USC § 103(a) as being unpatentable over Lencki et al., Wolff et al., and Smithies et al. as applied to claims 1 and 28 above, and further in view of Peach (U.S. 2001/0049611).

Claim 8 includes the feature of "transforming the application data into a secure digital file thereby creating a finalized health insurance application" by virtue of its being dependent on claim 1. Claim 33 includes the features of "an application data processor to transform the application data into a secure digital file thereby creating a finalized health insurance application" by virtue of its being dependent on claim 28. Peach, whether considered separately or in combination with Lencki and Wolff, fails to disclose or suggest these features. Thus, claims 8 and 33 are patentable in view of the Lencki, Wolff, and Peach combination and should be allowed.

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RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th, day of September 2007.

___Dawn R. Shaw___

Name

___(signature)___

Signature